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09/621516
07/21/00

Attorney's Docket No. 80,113-0079 (GEN-079) (D2344)
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Box Patent Application
Assistant Commissioner for Patents
Washington, D.C. 20231

NEW APPLICATION TRANSMITTAL

Transmitted herewith for filing is the patent application of
Inventor(s): **Christopher POLI; Christopher S. DEL SORDO; Douglas S. MAKOFKA; Jack BIRNBAUM; Thomas F. BATES IV; Dave PREZUHY; and Ira S. LEHRMAN**

For: **METHOD AND SYSTEM FOR DIRECTING THE DOWNLOAD OF SOFTWARE AND FIRMWARE OBJECTS OVER A NETWORK SUCH AS A CABLE TELEVISION SYSTEM**

1. Type of Application

This new application is for a(n)

- ☒ Original (nonprovisional)
- ☐ Design
 - ☐ Plant
- ☐ Divisional
- ☐ Continuation
- ☐ Continuation-in-part (C-I-P)

2. Benefit of Prior U.S. Application(s) (35 U.S.C. 119(e) 120, or 121)

- ☒ The new application being transmitted claims the benefit of prior U.S. application(s) and enclosed are ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED.

Serial No.: **60/152,286**

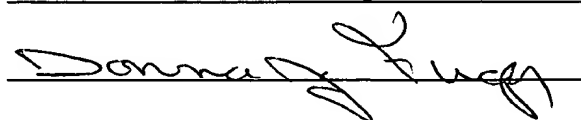
Filed: **September 3, 1999**

Status: **Pending**

CERTIFICATION UNDER 37 CFR 1.10

I hereby certify that this New Application Transmittal and the documents referred to as enclosed therein are being deposited with the United States Postal Service on this date July 21, 2000 in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number EL 489 897 790 US addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231.

Donna J. Fuga



(Application Transmittal page 1 of 6)

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3. **Papers Enclosed That Are Required for Filing Date under 37 CFR 1.53(b) (Regular) or 37 CFR 1.153 (Design) Application**

17 Pages of specification

4 Pages of claims

1 Pages of Abstract

4 Sheets of Drawing

☒ formal

☐ informal

☐ The enclosed drawing(s) are photograph(s), and there is also attached a "PETITION TO ACCEPT PHOTOGRAPH(S) AS DRAWING(S)". 37 CFR 1.84(b).

4. **Additional papers enclosed**

☐ Preliminary Amendment

☐ Information Disclosure Statement (37 CFR 1.98)

☐ Form PTO-1449

☐ Citations

☐ Declaration of Biological Deposit

☐ Submission of "Sequence Listing", computer readable copy and/or amendment pertaining thereto for biotechnology invention containing nucleotide and/or amino acid sequence.

☐ Authorization of Attorney(s) to Accept and Follow Instructions from Representative

☐ Special Comments

☐ Other

5. **Declaration or oath**

☒ Enclosed

Executed by

☒ inventor(s).

☐ legal representative of inventor(s).

☐ joint inventor or person showing a proprietary interest on behalf of inventor who refused to sign or cannot be reached.

☐ This is the petition required by 37 CFR 1.47 and the statement required by 37 CFR 1.47 is also attached. See item 13 below for fee.

☐ Not enclosed.

☐ Application is made by a person authorized under 37 CFR 1.41(c) on behalf of all the above named inventor(s).

☐ Showing that the filing is authorized.

6. Inventorship Statement

The inventorship for all the claims in this application are:

☐ The same.

or

☐ Not the same. An explanation, including the ownership of the various claims at the time last claimed invention was made, .

☐ is submitted

☐ will be submitted.

7. Language

☒ English

☐ Non-English

☐ The attached translation is a verified translation. 37 CFR 1.52(d).

8. Assignment

☒ An assignment of the invention to GENERAL INSTRUMENT CORPORATION.

☒ is attached. A separate ☒ "COVER SHEET FOR ASSIGNMENT (DOCUMENT) ACCOMPANYING NEW PATENT APPLICATION" or ☐ FORM PTO 1595 is also attached.

☐ will follow.

9. Certified copy

Certified copy(ies) of application(s)

country	appln. no.	filed
country	appln. no.	filed
country	appln. no.	filed
from which priority is claimed		
<input type="checkbox"/> is (are) attached.		
<input type="checkbox"/> will follow.		

10. Fee Calculation (37 CFR 1.16)

A. ☒ Regular application.

CLAIMS AS FILED			
Number Filed	Number Extra	Rate	Basic Fee 37 CFR 1.16(a) \$ 690.00
Total Claims (37 CFR 1.16(c))	20-20 = 0	X \$ 22.00	0000
Independent Claims (37 CFR 1.16(b))	2 -3 = 0	X \$ 80.00	00.00
Multiple dependent claims, if any, (37 CFR 1.16(d))		X \$ 260.00	00.00

- ☐ Amendment canceling extra claims enclosed.
☐ Amendment deleting multiple-dependencies enclosed
☐ Fee for extra claims is not being paid at this time.

Filing Fee Calculation \$ 690.00

B. ☐ Design application (\$310.00-37 CFR 1.16(f))
Filing Fee Calculation \$ _____

C. ☐ Plant application (\$510.00-37 CFR 1.16(g))
Filing Fee Calculation \$ _____

11. Small Entity Statement(s)

- ☐ Verified Statement(s) that this is a filing by a small entity under 37 CFR 1.9 and 1.27 is (are) attached.
☐ Status as a small entity was claimed in prior application serial no. _____, filed on _____, from which benefit is being claimed for this application under:

35 U.S.C. ☐ 119(e),
☐ 120,
☐ 121,
☐ 365(c),

and which status as a small entity is still proper and desired.

- ☐ A copy of the verified statement in the prior application is included.

Filing Fee Calculation (50% of A, B or C above) \$ _____

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12. Request for International-Type Search (37 CFR 1.104(d))

- ☐ Please prepare an international-type search report for this application at the time when national examination on the merits takes place.

13. Fee Payment Being Made At This Time

- ☐ Not enclosed.
☐ No filing fee is to be paid at this time.

☒ Enclosed

- | | |
|---|------------------|
| <input checked="" type="checkbox"/> Basic filing fee | \$ <u>690.00</u> |
| <input checked="" type="checkbox"/> Recording assignment (\$40.00; 37 CFR 1.21(h)) (See attached "COVER SHEET FOR ASSIGNMENT ACCOMPANYING NEW APPLICATION".) | \$ <u>40.00</u> |
| <input type="checkbox"/> Petition fee for filing by other than all the inventors or person on behalf of the inventor where inventor refused to or cannot be reached. (\$130.00, 37 CFR 1.47 and .17(h)) | \$ _____ |
| <input type="checkbox"/> For processing an application with a specification in a non-English language. (\$130.00; 37 CFR 1.52(d) and 1.17(k). | \$ _____ |
| <input type="checkbox"/> Processing and retention fee (\$130.00; 37 CFR 1.153(d) and 1.21 (i)) | \$ _____ |
| <input type="checkbox"/> Fee for international-type search report (\$40.00; 37 CFR 1.21(e)) | \$ _____ |

Total fees enclosed \$ 730.00

14. Method of Payment of Fees

- ☐ Check in the amount of \$____.
- ☒ Charge Deposit Account No. 18-0013 in the amount of \$730.00.
A duplicate of this transmittal is attached.

15. Authorization to Charge Additional Fees

- ☒ The Commissioner is hereby authorized to charge the following additional fees by this paper and during the entire pendency of this application to Deposit Account No. 18-0013
- ☒ 37 CFR 1.16(a), (f) or (g) (filing fees)
- ☒ 37 CFR 1.16(b), (c) and (d) (presentation of extra claims)
- ☒ 37 CFR 1.16(e) (surcharge for filing the basic filing fee and/or declaration on a date later than the filing date of the application)
- ☒ 37 CFR 1.17 (application processing fees)
- ☐ 37 CFR 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 CFR 1.311(b))

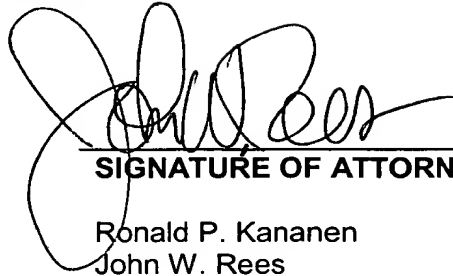
16. Instructions as to Overpayment

- ☒ Credit Deposit Account No. 18-0013
☐ Refund

Date: July 21, 2000

Reg. No. 24,104
Reg. No. 38,278
Telephone No. (248) 594-0624

Customer No. 010291



SIGNATURE OF ATTORNEY

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Bloomfield Hills, MI 48304

☒ Incorporation by reference of added pages

- ☒ Plus added pages for New Application Transmittal where benefit of prior U.S. application(s) claimed

Number of pages added 5

- ☐ Plus Added Pages for Papers Referred to in item 4 above

Number of pages added _____

- ☐ Plus "Assignment Cover Letter Accompanying New Application"

Number of pages added _____

☐ Statement Where No Further Pages Added

- ☐ This transmittal ends with this page.

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EXPRESS LABEL NO. EL 489 897 790 US

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**ADDED PAGES FOR APPLICATION TRANSMITTAL WHERE BENEFIT OF
PRIOR U.S. APPLICATION(S) CLAIMED**

NOTE: See 37 C.F.R. § 1.78.

17. Relate Back

WARNING: If an application claims the benefit of the filing date of an earlier filed application under 35 U.S.C. 120, 121 or 365(c), the 20-year term of that application will be based upon the filing date of the earliest U.S. application that the application makes reference to under 35 U.S.C. 120, 121 or 365(c). (35 U.S.C. 154(a)(2) does not take into account, for the determination of the patent term, any application on which priority is claimed under 35 U.S.C. 119, 365(a) or 365(b).) For a c-i-p application, applicant should review whether any claim in the patent that will issue is supported by an earlier application and, if not, the applicant should consider canceling the reference to the earlier filed application. The term of a patent is not based on a claim-by-claim approach. See Notice of April 14, 1995, 60 Fed. Reg. 20,195, at 20,205.

(complete the following, if applicable)

☒ Amend the specification by inserting, before the first line, the following sentence:

A. 35 U.S.C. 119(e)

NOTE: "Any nonprovisional application claiming the benefit of one or more prior filed copending provisional applications must contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior provisional application, identifying it as a provisional application, and including the provisional application number (consisting of series code and serial number)." 37 C.F.R. § 1.78(a)(4).

☒ "This application claims the benefit of U.S. Provisional Application(s) No(s).:

APPLICATION NO(S).:

FILING DATE

60/152,286

09/03/1999

B. 35 U.S.C. 120, 121 and 365(c)

NOTE: "Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. . . . Cross-references to other related applications may be made when appropriate." (See § 1.14(a)). 37 C.F.R. § 1.78(a)(2).

☐ "This application is a

☐ continuation

☐ continuation-in-part

☐ divisional

of copending application(s)

☐ application number _____ filed on _____"

☐ International Application _____ filed on _____ and which designated the U.S."

NOTE: The proper reference to a prior filed PCT application that entered the U.S. national phase is the U.S. serial number and the filing date of the PCT application that designated the U.S.

NOTE: (1) Where the application being transmitted adds subject matter to the International Application, then the filing can be as a continuation-in-part or (2) if it is desired to do so for other reasons then the filing can be as a continuation.

NOTE: The deadline for entering the national phase in the U.S. for an international application was clarified in the Notice of April 28, 1987 (1079 O.G. 32 to 46) as follows:

"The Patent and Trademark Office considers the International application to be pending until the 22nd month from the priority date if the United States has been designated and no Demand for International Preliminary Examination has been filed prior to the expiration of the 19th month from the priority date and until the 32nd month from the priority date if a Demand for International Preliminary Examination which elected the United States of America has been filed prior to the expiration of the 19th month from the priority date, provided that a copy of the international application has been communicated to the Patent and Trademark Office within the 20 or 30 month period respectively. If a copy of the international application has not been communicated to the Patent and Trademark Office within the 20 or 30 month period respectively, the international application becomes abandoned as to the United States 20 or 30 months from the priority date respectively. These periods have been placed in the rules as paragraph (h) of § 1.494 and paragraph (i) of § 1.495. A continuing application under 35 U.S.C. 365(c) and 120 may be filed anytime during the pendency of the international application."

☐ "The nonprovisional application designated above, namely application _____, filed _____, claims the benefit of U.S. Provisional Application(s) No(s):

APPLICATION NO(S):

FILING DATE

☐ Where more than one reference is made above please combine all references into one sentence.

18. Relate Back—35 U.S.C. 119 Priority Claim for Prior Application

The prior U.S. application(s), including any prior International Application designating the U.S., identified above in item 17B, in turn itself claim(s) foreign priority(ies) as follows:

Country	Appln. no.	Filed
The certified copy(ies) has (have)		
<input type="checkbox"/> been filed on _____, in prior application _____, which was filed on _____.		
<input type="checkbox"/> is (are) attached.		

WARNING: The certified copy of the priority application that may have been communicated to the PTO by the International Bureau may not be relied on without any need to file a certified copy of the priority application in the continuing application. This is so because the certified copy of the priority application communicated by the International Bureau is placed in a folder and is not assigned a U.S. serial number unless the national stage is entered. Such folders are disposed of if the national stage is not entered. Therefore, such certified copies may not be available if needed later in the prosecution of a continuing application. An alternative would be to physically remove the priority documents from the folders and transfer them to the continuing application. The resources required to request transfer, retrieve the folders, make suitable record notations, transfer the certified copies, enter and make a record of such copies in the Continuing Application are substantial. Accordingly, the priority documents in folders of international applications that have not entered the national stage may not be relied on. Notice of April 28, 1987 (1079 O.G. 32 to 46).

19. Maintenance of Copendency of Prior Application

NOTE: The PTO finds it useful if a copy of the petition filed in the prior application extending the term for response is filed with the papers constituting the filing of the continuation application. Notice of November 5, 1985 (1060 O.G. 27).

- A. ☐ Extension of time in prior application

(This item **must** be completed and the papers filed **in the prior application**, if the period set in the prior application has run.)

- ☐ A petition, fee and response extends the term in the pending **prior** application until
- ☐ A **copy** of the petition filed in prior application is attached.

- B. ☐ Conditional Petition for Extension of Time in Prior Application

(complete this item, if previous item not applicable)

- ☐ A conditional petition for extension of time is being filed in the pending **prior** application.
- ☐ A **copy** of the conditional petition filed in the prior application is attached.

20. Further Inventorship Statement Where Benefit of Prior Application(s) Claimed

(complete applicable item (a), (b) and/or (c) below)

- (a) ☐ This application discloses and claims only subject matter disclosed in the prior application whose particulars are set out above and the inventor(s) in this application are
- ☐ the same.
- ☐ less than those named in the prior application. It is requested that the following inventor(s) identified for the prior application be deleted:

(type name(s) of inventor(s) to be deleted)

- (b) ☐ This application discloses and claims additional disclosure by amendment and a new declaration or oath is being filed. With respect to the prior application, the inventor(s) in this application are
- ☐ the same.
- ☐ the following additional inventor(s) have been added:

(type name(s) of inventor(s) to be deleted)

- (c) ☐ The inventorship for all the claims in this application are
- ☐ the same.
- ☐ not the same. An explanation, including the ownership of the various claims at the time the last claimed invention was made
- ☐ is submitted.
- ☐ will be submitted.

21. Abandonment of Prior Application *(if applicable)*

- ☐ Please abandon the prior application at a time while the prior application is pending, or when the petition for extension of time or to revive in that application is granted, and when this application is granted a filing date, so as to make this application copending with said prior application.

NOTE: According to the Notice of May 13, 1983 (103, TMOG 6-7), the filing of a continuation or continuation-in-part application is a proper response with respect to a petition for extension of time or a petition to revive and should include the express abandonment of the prior application conditioned upon the granting of the petition and the granting of a filing date to the continuing application.

22. Petition for Suspension of Prosecution for the Time Necessary to File an Amendment

WARNING: "The claims of a new application may be finally rejected in the first Office action in those situations where (1) the new application is a continuing application of, or a substitute for, an earlier application, and (2) all the claims of the new application (a) are drawn to the same invention claimed in the earlier application, and (b) would have been properly finally rejected on the grounds of art of record in the next Office action if they had been entered in the earlier application." MPEP, § 706.07(b), 6th ed., rev.2. ☐

NOTE: Where it is possible that the claims on file will give rise to a first action final for this continuation application and for some reason an amendment cannot be filed promptly (e.g., experimental data is being gathered) it may be desirable to file a petition for suspension of prosecution for the time necessary.

(check the next item, if applicable)

- ☐ There is provided herewith a Petition To Suspend Prosecution for the Time Necessary to File An Amendment (New Application Filed Concurrently)

23. Small Entity (37 CFR § 1.28(a))

- ☐ Applicant has established small entity status by the filing of a statement in parent application _____ on _____.
☐ A copy of the statement previously filed is included.

WARNING: See 37 CFR § 1.28(a).

24. NOTIFICATION IN PARENT APPLICATION OF THIS FILING

- ☐ A notification of the filing of this (check one of the following)
☐ continuation
☐ continuation-in-part
☐ divisional

is being filed in the parent application, from which this application claims priority under 35 U.S.C. § 120.

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